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2431-102



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
F. CESARE)
Serial No. 09/138,926) Examiner: S. Nolan
Filed: August 24, 1998) Group Art Unit: 1772
For: LOW MOLECULAR WEIGHT) Confirmation No.: 4707
POLYMERS AND THEIR USE)
AS DISPERSION AIDS)

RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

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Sir:

This is in response to the Office Action mailed
September 25, 2003.

Applicant notes with appreciation the withdrawal of all
of the rejections made in the February 20, 2003 Action.
The new rejections are discussed below.

35 USC §102

Reconsideration and withdrawal of the rejection of
claims 1-10, 13-22 and 27-30 under 35 USC §102(b) as being
anticipated by Meynard are respectfully requested.

First, it is respectfully submitted that the present rejection is the latest in a continuing series of improper piecemeal rejections. The present application had pended for over five years, and the outstanding Action is the *eighth* Action in the case, and the *third* Action, applying different references, since the claims were found free from the prior art on May 24, 2002. The present rejection is simply an improper piecemeal examination:

To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. ***Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.***

MPEP §706.07 (emphasis added). Rejecting the present claims under a reference that was ostensibly searched for subsequent to applicant's response to the February 20, 2003 Action is certainly switching references at the eleventh hour, and defeats the goal of reaching a clearly defined issue for an early termination.

The process is particularly inappropriate when it is considered the the Action has misapplied the reference. Meynard discloses that ethylene-propylene copolymers can be combined with bitumen with the assistance of a polyolefin dissolving intermediary. The Action maintains that Meynard discloses the molecular weight of the copolymer and that it is a solid at room temperature, but that is not the case.

With respect to molecular weight, the Action cites column 2, line 39 as showing a weight of 2,000 to 500,000. However, *that is the molecular weight of the polyolefin dissolving intermediary, not of the ethylene-propylene copolymer:*

a solid dissolving intermediary is used which consists of at least one saturated or unsaturated, linear or branched polyolefin having a mean molecular weight ranging from about 2,000 to about 500,000 . . . [col. 2, lines 35-39]

Thus, contrary to the Examiner's assertion, Meynard does not disclose any molecular weight for the ethylene-propylene copolymer. Indeed, given the Meynard disclosure that the ethylene-propylene copolymer should have a high mechanical strength (e.g., col. 3, lines 60-62), one would understand that very high molecular weight materials were being used.

The Action also relies on lines 8, 36 and 52 of column 5 as disclosing that the EP copolymer is solid at room

temperature, but those portions of the disclosure do not so state. The Examples cited in the Action do not disclose that the EP copolymer is a granulate at 121°C; rather they disclose that the *mixture* of the EP copolymer and the polyethylene is a granulate. Thus, that claim element is not found in Meynard.

Meynard also lacks disclosure of the additional elements found in claim 28, which recites various molded articles, such as belts, hoses, etc. The Action alleges that claim 28 goes to intended use which does not distinguish Meynard, but that is incorrect. Claim 28 recites a moulded article in various forms. In contrast, those forms are not disclosed in Meynard. Where is there disclosure of a v-belt, or of a timing belt, etc.? There is none, and Meynard cannot anticipate claim 28. Moreover, Meynard does not mention the needle penetration test of claims 9 and 22.

35 USC §103

Reconsideration and withdrawal of the rejection of claims 11-12 and 23-24 under 35 USC §103(a) as being obvious over Meynard in view of Frances are respectfully requested. That combination does not make out a *prima facie* case of obviousness of any of the rejected claims.

As discussed above, Meynard fails to teach the molecular weight of the EP copolymers, and their physical state at room temperature. Frances does not fill in that gap. Frances is directed to the production of particulate elastomeric compositions that may be used to incorporate aramid pulp into elastomers. The aramid pulp is first mixed with a reinforcing filler, to which is added a solution of elastomer in an organic solvent. That mixture is preferably dried to remove the solvent, leaving an elastomeric composition that may be used as is, or for blending the aramid pulp into the same or a different elastomer (column 1, line 44-column 2, line 5). In all Examples, the aramid pulp was premixed with a solution of some sort of rubber (natural, Neoprene or SBR) in toluene.

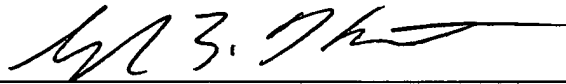
Thus, Frances teaches away from the present claims. Frances teaches blending aramid pulp with an elastomeric *solution*. In contrast, the present claims recite that the terpolymer is a *solid* at room temperature. There is nothing in Frances (or Meynard, see above) to suggest that feature.

Reconsideration and withdrawal of the rejection of claims 25-26 under 35 USC §103(a) as being obvious over Frances in view of Meynard are respectfully requested. As shown above, that combination lacks a teaching of all of

the claim elements, and hence it does not make out a *prima facie* case of obviousness of any of the rejected claims.

Applicant submits that the present application is in condition for allowance. Reconsideration and favorable action are earnestly requested.

Respectfully submitted,



Glenn E. Karta
Attorney for Applicant
Registration No. 30,649
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
Suite 800, 1425 K Street, N.W.
Washington, D.C. 20005
Telephone: (202) 783-6040